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IN THE

Supreme Court of the United States

October Term 1965
No. 482

VINCENT W. ECKEL,

Petitioner,

vs.

DAVID L. LADD, Commissioner of Patents,

Respondent.

Petitioner's Reply to Memorandum for the Commissioner of Patents in Opposition to Petition for Writ of Certiorari.

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The Memorandum for the Commissioner of Patents in an undisciplined manner seeks to establish that only questions of fact are involved and that the District Court properly applied the test of "obviousness" as required by 35 U.S.C. 103.

The Commissioner's Memorandum states:

> ". . . the court found that, although the Gachon patent did not expressly state what materials its casing or the annular T-shaped sleeve was made of (Pet. App. 8), the Gachon device was 'operable with a magnetizable casing' and 'Gachon's sleeve of T-shaped cross-section was made of non-magnetizable material' (Pet. App. 9)."

The foregoing quotation erroneously creates the impression that the District Court unequivocally "found that . . . 'Gachon's sleeve of T-shaped cross-section was made of non-magnetizable material' ".

Such was not the case. Taken from context the quotation is misleading. The District Court actually said:

> "Similarly, provision of a non-magnetizable sleeve within the core of a coil was shown by the Fuscaldo patent to be a conventional method for concentrating magnetic force upon a 'working' air gap. To assert that the annular sleeve of Gachon, identically positioned, was not used for the same purpose is to completely ignore its existence in the drawing. No other reason was advanced for its presence, and no other reason seems plausible. It must be concluded that although the language of the patent does not expressly say so, Gachon's sleeve of T-shaped cross-section was made of non-magnetizable material."

Clearly the Court in view of the prior art *concluded* that "Gachon's sleeve of T-shaped cross-section was made of non-magnetizable material.", but that it arrived at that conclusion by applying the test that it was "obvious" is contradicted by its own explanation of its thinking.

The test which the Court applied is found only in the Court's own words that:

> ". . . the Court cannot say that plaintiff's subject matter would have been unobvious . . ."

On page 4 of its brief in the second paragraph, Commissioner's Memorandum is misleading upon the same question and as follows:

> "Petitioner's contention that the district court ruled that a patent must be denied unless it can be said that the invention was 'unobvious', thereby applying an erroneous legal standard, is based on a misreading of this language in its context. The court expressly stated that 'it appears to the Court that the plaintiff's structure is completely disclosed' by the prior art (Pet. App. 9), . . ."

A reading of the Court's Opinion discloses that what the court meant was that applying its erroneous unobvious test applicant's invention was completely disclosed. That the invention was not completely disclosed in the basic Gachon reference is pointed out in detail in the Petition beginning at the second paragraph on page 6 and continuing through the first paragraph on page 8.

The District Court clearly stated:

> ". . . we definitely did not, as alleged in the petition, reach a conclusion that, unequivocally, the member is made of non-magnetic material." [R. 234.]

Having so stated, and having reached the conclusion that no invention was required to make the member of non-magnetic material, the sole question which remains is the test which the District Court applied.

The answer to that question is found in the court's own words which were:

> "Manifestly, the Court cannot say that plaintiff's subject matter would have been unobvious in view of Gachon and Fuscaldo to a person skilled in the art to which all of these disclosures pertain."

The mere statement of the facts to which the Court applied its test does not refute its own explanation.

Conclusion.

The position of the Commissioner in its Memorandum is based upon the necessary premise that the District Court was careless and undisciplined in its use of language and that it should not be understood to mean what it said.

A United States District Court is presumed to say what it means and it said that:

> ". . . the Court cannot say that plaintiff's subject matter would have been unobvious . . ."

The granting of the petition is respectfully requested.

Dated: September 21, 1965.

Respectfully submitted,

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